

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/712,795	Applicant(s) CROOKE ET AL.
Examiner Janet L. Epps-Ford	Art Unit 1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 142-145, 197-212, 225, 227-235, 239-240 for the reasons of record.
Claim(s) objected to: 125, 126, 129-141, 221-224, 226 and 236-238, for the reasons of record.
Claim(s) rejected: 127, 128 and 216-220, for the reasons of record.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 4/08/2008
13. ☒ Other: See attached PTO-892.

/Janet L. Epps-Ford/
Primary Examiner, Art Unit 1633

Continuation of 3. NOTE: Applicants have amended claim 216 to recite "an antisense oligonucleotide 20 nucleobases in length comprising at least 13 contiguous nucleobases of SEQ IDNO: 247, or a salt form thereof." Moreover, Applicants have added new claim 241 which depends from amended claim 216, wherein the antisense oligonucleotide is fully complementary to SEQ ID NO: 3. The newly added limitations, especially as set forth in claim 241 have not been previously considered in the context of newly amended claim 216. Moreover, Applicants have added new claims 242-246. Furthermore, Applicant's amendment to claim 216 would potentially necessitate a new grounds of rejection, for example under 102 as anticipated by WO 9413794 A1, which discloses a nucleic acid primer of 20 bases pairs in length and comprises a 13 base pair contiguous sequence of SEQ ID NO: 247.

Although Applicants argue that a new search would not be necessitated in response to Applicant's amendment to the claims, it is clear that the nucleic acid databases at the USPTO grow on a daily basis, therefore any amendment that would change the scope of the claims (even narrowing) would necessitate an updated search. Moreover, with the publication of pre-grant patent applications, there is also the possibility of a US patent application having an earlier priority date than the instant application becoming publicly available, and potentially reading on the amended claims. Therefore an updated search is considered necessary in the instant case.

Moreover, Applicants arguments appear to be directed the claims as set forth in the amendment filed 4/08/2008. Since this amendment was not entered, Applicant's arguments are considered moot, and the status of the claims remains as set forth in the prior Office Action.